



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,644	11/28/2001	Robert Gary Goodman	PF02047NA/10-33	8587

20280 7590 02/27/2006

MOTOROLA INC
600 NORTH US HIGHWAY 45
ROOM AS437
LIBERTYVILLE, IL 60048-5343

EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT PAPER NUMBER

2145

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,644

Applicant(s)

GOODMAN ET AL.

Examiner

Azizul Choudhury

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7-9,11-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-9,11-17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/28/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

This office action is in response to the correspondence received on December 9, 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-5, 7-9, 11-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theriault et al. (US Pat No: 6,049,821) in view of Cohen-Levy et al. (US Pat. No: 5,423,034), hereafter referred to as Theriault and Cohen, respectively.

1. As to Claim 1, Theriault teaches through Cohen:

Retrieving the file from a server (see column 8, lines 34-36, Theriault); Evaluating the file to determine whether resources required for utilization of the file are available (see column 10, lines 27-30 and 39-42; column 18, lines 39-52; column 19, lines 58-62; and column 20, lines 51-53, Theriault); Forwarding the file to the consumer when said resources are available (see column 10, lines 27-30 and lines 39-42, Theriault); and Forwarding a message corresponding to the file to the consumer of the file when the resources are unavailable (see column 18, lines 39-52; column 19, lines 58-67; and column 20, lines 51-53, Theriault), wherein the message indicates that appropriate resources are unavailable (see column 10, lines 27-30 and 39-42;

column 18, lines 39-52; column 19, lines 58-62; and column 20, lines 51-53, Theriault) and asks the consumer whether file information should be saved or not for later consumption (see column 15, lines 19-30, Cohen).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

2. As to Claim 4 Theriault teaches through Cohen:

Wherein said step of evaluating said file includes a step of assessing communications unit resources required for utilization of said file (see column 10, lines 27-30 and lines 39-45, Theriault).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

3. As to Claims 5 and 17 Theriault teaches through Cohen:

Wherein said step of assessing said communications unit resources includes determining one of a size of the file (see column 16, lines 7-9, Theriault), a graphic content of the file (see column 17, lines 39-41, Theriault), a post transport processing capacity corresponding to the file (see column 10, lines 43-45, Theriault), and a display capability required for the file (see column 17, lines 27-30, Theriault).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

4. With respect to claims 7 and 19 Theriault teaches through Cohen:

Theriault teaches the method further including a step of forwarding a message that provides a choice of locations for storing said one of the files and said address for the file (see Cohen et, al: column 15, lines 19-30).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a

feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

5. With respect to Claims 8 and 20 Theriault teaches through Cohen:

Theriault teaches triggering a reminder corresponding to said file for the consumer at a communications unit and removing said reminder when said file has been accessed (see column 18, lines 39-52; column 19, lines 58-67; column 20, lines 51-53).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

6. As to Claim 9 Theriault teaches through Cohen:

A transceiver for interfacing to a radio access network (see column 1, line 35; column 4, lines 29-31; column 6, line 40; and column 22, lines 21-22, Theriault); A user input output (I/O) including a display (see column 6, lines 39-42, Theriault); and

a controller, couple to said transceiver and said user I/O, further comprising a browser that operates to: request a file located at a network server (see column 3, lines 43-45, Theriault), receive the file when network resources are available to transport said file (see column 10, lines 27-30 and lines 39-42, Theriault), and receive a message corresponding to the file when said resources are unavailable (see column 18, lines 39-52; column 19, lines 58-67; column 20, lines 51-53, Theriault), wherein said message is coupled to said display (see column 10, lines 27-30 and 39-42; column 18, lines 39-52; column 19, lines 58-62; and column 20, lines 51-53, Theriault) and offers a choice of saving or not saving file information (see column 15, lines 19-30, Cohen).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

7. With respect to Claims 11, and 18 Theriault teaches through Cohen:

Theriault teaches the limitations of Claims 9 and 13 as noted above, as well as saving the file, but fail to teach specifically query the user for a saving location.

Cohen teach wherein said message is coupled to said display and offers a choices

of saving one of said file and an address for said file (see Cohen et. al: column 15, lines 19-30) and wherein said message offers a choice of locations for saving said one of said file and said address for said file (see Cohen et. al: column 15, lines 19-30).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

8. As to Claim 12 Theriault teaches through Cohen:

Wherein a reminder corresponding to said file is shown on said display until said file is received (see column 18, lines 39-52; column 19, lines 58-67; column 20, lines 51-53, Theriault).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the

teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

9. As to Claim 13 Theriault teaches through Cohen:

A gateway operating to selectively forward files to a communications device, the gateway comprising in combination: a first port arranged to communicate with the communications device (see column 5, lines 45-48, Theriault); a second port arranged to communicate with a server (see column 5, lines 50-51, Theriault); and a controller, coupled to said first port and to said second port (see column 5, lines 55-59, Theriault), operating as an agent for the communications device for: retrieving a file from said server (see column 8, lines 34-36, Theriault); evaluating said file to determine whether resources required for utilization of said file are available (see column 10, lines 27-30 and lines 39-42, Theriault); forwarding said file to the communications device when said resources are available (see column 10, lines 27-30 and lines 39-42, Theriault); and forwarding a message corresponding to said file to the communications device when the resources are unavailable (see column 18, lines 39-52; column 19, lines 58-67; and column 20, lines 51-53, Theriault), wherein the message indicates that appropriate resources are unavailable (see column 10, lines 27-30 and 39-42; column 18, lines 39-52; column 19, lines 58-62; and column 20, lines 51-53, Theriault) and asks whether file information should be saved or not (see column 15, lines 19-30, Cohen).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

10. As to Claim 14 Theriault teaches through Cohen:

Wherein evaluating said file includes assessing whether radio network resources are available to transport said file (see column 22, lines 21-26 and 45-48, Theriault).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

11. As to Claim 15 Theriault teaches through Cohen:

Wherein said assessing further includes determining whether a channel with appropriate quality of service is available for transporting said file (see column 22, lines 45-48, Theriault).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

12. As to Claim 16 Theriault teaches through Cohen:

Wherein said evaluating said file includes a step of assessing communications device resources required for utilization of said file (see column 10, lines 27-30 and lines 39-45, Theriault).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

13. As to Claim 21 Theriault teaches through Cohen:

Operating to trigger a reminder corresponding to said file at a second communications device (column 21, lines 41-60, Theriault).

While Theriault teaches a design for selectively forwarding a file to a consumer of the file, Theriault does not teach the features of allowing the consumer to save the file if appropriate resources are unavailable. Cohen however does teach such a feature (see column 15, lines 19-30, Cohen). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Theriault with those of Cohen, in order to allow users to easily locate and find information about the files saved (column 6, lines 40-43, Cohen).

14. Claim 22 is rejected under 25 U.S.C. 103(a) as being unpatentable over Theriault teaches communicating a reminder to a user with a non-proxy communications service (column 21, lines 41-60). Theriault does not teach the specific use of email. However, Official Notice is hereby taken that email is a well-known technology used to quickly and efficiently communicate electronically. It would have be obvious to one of ordinary skill in the art at the time of the invention to use email in the invention of Theriault in order to speed up the communications with the client, and to make those communications more efficient. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Theriault with the Network File Management of Cohen,

which are from the same field of endeavor, in order to allow users to easily locate and find information about the files saved (see Cohen: column 6, lines 40-43).

Response to Remarks

The amendment received on December 9, 2005 has been carefully examined but is not deemed fully persuasive. The amendments feature some cancelled claims whose features are appended to the independent claims. The revised office action has been compiled to reflect such claim amendments and appropriately cites the prior arts previously used for each of the currently claimed features.

Within the remarks portion of the amendment, the applicant's representative remarks how the Cohen prior art does not provide a message offering a choice of saving or not saving the file information. The examiner disagrees with this argument. Cohen provides a window allowing the user to save a file to a desired location (column 15, lines 19-30, Cohen). For further evidence of such features lacking novelty, the applicant's representative is invited to refer to the Toga patent (US Pat No: 5,987,504) (column 8, lines 37-56).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/994,644
Art Unit: 2145

Page 14

AC



JASON CARDONE
SUPERVISORY PATENT EXAMINER